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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,333	10/16/2001	Wataru Yagi	214958US0	1648

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ALEXANDRIA, VA 22314

EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,333

Applicant(s)

YAGI ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 and 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 9, 10, 17-20 and 25 is/are rejected.
- 7) ☒ Claim(s) 2-8, 21 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-10, 17-21, 25 and 26 in Paper No. 10 is acknowledged. The traversal is on the ground(s): (1) that in making the restriction requirement the Examiner has "made an unsupported conclusion" and provided no support for the statements, that applicants' claimed process can be used to make another and materially powder having any number of crystal grains and that the claimed product can be made by another and materially different process; (2) that the Examiner has not demonstrated that to examine all inventions would entail a burden on the Examiner and that because all inventions are classified in class 148 there is no serious burden on the Examiner. This is not found persuasive because The Examiner's allegation that a different process can be used to make the claimed product and/or that the claimed process can be used to make a product different than the claimed product does not need to be documented, MPEP 806.05(f). Although the inventions have been classified in the same class, to search each of the grouped inventions would require additional searching within class 148. On the face of it, applicants' traversal would have it that any inventions that are classified in a single class, such as class 148, do not present an additional search burden to the Examiner even if an entire class must be searched there is no additional burden on the Examiner. Further, to examine all sets of claims in the same application would require not only additional searching but also

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would require consideration of additional 112 issues, prior art, formulation of rejections, etc.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

1. The information disclosure statement filed February 13, 2003 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. In claim 10, line 2, the particles are claimed as "connected to each other".

In view of the word "connected" it is not clear whether the claim is directed to merely a metal powder or a compacted metal powder.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 17, 18, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frischmann (US Patent No. 4,197,146).

Frischmann teaches a magnetic amorphous alloy powder (column 2, lines 63 to 65) that can be 100% amorphous (column 3, lines 48 to 49) having a composition that overlaps the alloy composition recited in applicants' claim 25 (column 3, lines 14 to 22). Frischmann's powder can be used to form composites with or without a binder (column 3, lines 54 to 56) as recited in applicants' claim 17.

The claims and Frischmann differ in that Frischmann is silent with respect to the applicants' claim limitation, "no greater than ten crystal particles...in its cross-section" (claim 1, line 2).

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because applicants' claim language, "no greater than ten crystal particles...in its cross-section" (claim 1, line 2) encompasses the embodiment wherein the claimed powder has zero crystal grains, that is, wherein the powder is amorphous. In view of this, applicants' claims encompass Frischmann's embodiment wherein the powder is 100% amorphous powder.

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5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Frischmann (US Patent No. 4,197,146).

Frischmann teaches and is applied as set forth above.

Claim 9 and Frischmann differ in that Frischmann does not teach the process step recited in product by process claim 9.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the process limitations recited in instant product by process claim 9 does not necessarily lend patentability to the claimed product, MPEP 2113.

6. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frischmann (US Patent No. 4,197,146).

Frischmann teaches and is applied as set forth above. Frischmann further teaches that the compaction step used to make Frischmann's compact can be a hot pressing step (column 4, lines 17 to 20) as recited in applicants' claims 19 and 20.

Frischmann and claims 19 and 20 differ in that Frischmann is silent with respect to the temperature of the hot pressing step.

However one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because it is well within the skill of one of ordinary skill in the art to determine the appropriate hot pressing temperature to use in preparing Frischmann's hot pressed composite.

Allowable Subject Matter

7. Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Claims 2 to 8, 21 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 2 to 8 and 10 the primary reason for indicating allowable subject matter is that none of the references alone or in combination teach or suggest a coated soft magnetic powder comprising a majority of particles each of which has no greater than ten crystal grains on the average in its cross section.

Regarding claim 21 the primary reason for indicating allowable subject matter is that none of the references alone or in combination teach or suggest a method of making a composite comprising compacting soft magnetic powder comprising a majority of particles each of which has no greater than ten crystal grains on the average in its cross section at a pressure of 4.5 to 7 tonf/cm².

Regarding claim 26 the primary reason for indicating allowable subject matter is that none of the references alone or in combination teach or suggest a soft magnetic powder comprising a majority of particles each of which has no greater than ten crystal

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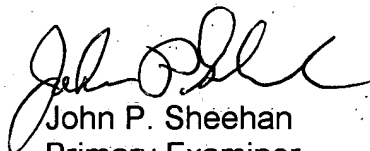
grains on the average in its cross section having a powder particle size of 10 to 300 microns.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



John P. Sheehan
Primary Examiner
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jps